

ESTTA Tracking number: **ESTTA425677**Filing date: **08/17/2011**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Redbox Automated Retail, LLC
Granted to Date of previous extension	08/17/2011
Address	One Tower Lane, Suite 1200 Oakbrook Terrace, IL 60181 UNITED STATES
Attorney information	James P. Muraff Neal, Gerber & Eisenberg LLP Two North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES jmuraff@ngelaw.com, mhall@ngelaw.com, khinner@ngelaw.com

**Applicant Information**

Application No	85135579	Publication date	04/19/2011
Opposition Filing Date	08/17/2011	Opposition Period Ends	08/17/2011
Applicant	Barnes, Stanley Lee 3127 St. Vincent St. Louis, MO 63104 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 2010/09/15 First Use In Commerce: 2010/09/15  
All goods and services in the class are opposed, namely: Providing kiosks at retailers for the payment of traffic citations

**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**


U.S. Registration No.	2919854	Application Date	01/08/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING MACHINES

U.S. Registration No.	2988869	Application Date	01/08/2003
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 Automated DVD rental services		

U.S. Registration No.	3082012	Application Date	11/10/2004
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING SERVICES, NAMELY, PROVIDING RETAIL FACILITIES FEATURING AUTOMATED DVD RENTAL		

U.S. Registration No.	3229436	Application Date	04/20/2006
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	REDBOX		

Design Mark	
Description of Mark	The mark consists of the word "redbox" with an arc over the word.
Goods/Services	Class 009. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Vending machines Class 041. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Rental of pre-recorded DVDs on a variety of subjects through automated vending machines

Attachments	78514282#TMSN.jpeg ( 1 page )( bytes ) 78866011#TMSN.jpeg ( 1 page )( bytes ) NoticeofOppositionREDBOXTICKETSLLC.pdf ( 10 pages )(423453 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/James P. Muraff/
Name	James P. Muraff
Date	08/17/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application	)	
Serial No.: 85/135579	)	
	)	
Published in the Official Gazette	)	
On April 19, 2011	)	
	)	
REDBOX AUTOMATED RETAIL, LLC	)	
	)	
Opposer,	)	<b>NOTICE OF OPPOSITION</b>
v.	)	
	)	
Stanley Lee Barnes	)	
DBA Red Box Tickets USA, LLC	)	
	)	
Applicant.	)	

This Notice of Opposition is submitted in the matter of Application Serial No. 85/135579, for registration by Stanley Lee Barnes, of the term RED BOX TICKETS USA, LLC based on their use of that term in connection with “providing kiosks at retailers for the payment of traffic citations” in International Class 36, which published for opposition in the *Official Gazette* on April 19, 2011. Redbox Automated Retail, LLC, a Delaware Limited Liability Company having a place of business at One Tower Lane, Oakbrook Terrace, Illinois 60181, believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. Redbox Automated Retail, LLC, is a vendor of automated DVD rental services through automated kiosks. Opposer has more than 27,000 locations nationwide and has serviced over 40 million different customers. Opposer has REDBOX automated kiosks located across the United States in Quick Service Restaurants (QSR), pharmacies, grocery stores, discount stores, convenience stores, train stations, airports, and other locations nationwide.

2. For many years, and before the acts of Applicant alleged herein, Opposer has provided automated DVD rental services through kiosks at retailers under and in connection with its REDBOX trademark and trade name, establishing both common law rights as well as rights under the Lanham Act. Indeed, Opposer has devoted significant resources, time and effort to marketing and promoting its automated DVD rental services under the REDBOX trademark and trade name. Opposer maintains a website under the domain name [www.redbox.com](http://www.redbox.com), which is available to all members of the trade and public, and which promotes its REDBOX kiosks and showcases its services.

3. As a result of the foregoing, Opposer has obtained a registration for the trademark REDBOX for use in connection with automated DVD rental services, including Registration Nos. 2,919,854, 2,988,869, 3,082,012, and 3,229,436, among others. Copies of the Trademark Registrations are attached hereto as Exhibit A. Opposer's REDBOX trademark, and its registration therefore, is now among its most valuable assets.

5. On September 22, 2010, long after Opposer began use of its REDBOX trademark, Applicant filed an application to register the term RED BOX TICKETS USA, LLC based upon use in connection with "providing kiosks at retailers for the payment of traffic citations".

6. Applicant's use and registration of the term RED BOX TICKETS USA, LLC as a trademark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe Applicant's services are Opposer's services, or are in some way legitimately connected with, sponsored by, or approved by Opposer in violation of 15 U.S.C. § 1052(d). Additionally, Applicant's use of the term RED BOX TICKETS USA, LLC would dilute Opposer's distinctive and valuable REDBOX trademark in violation of 15 U.S.C. § 1125(c). Applicant's registration of the term RED BOX TICKETS USA, LLC would, therefore,

damage Opposer, and on that basis, Opposer opposes registration of the term RED BOX TICKETS USA, LLC by Applicant.

WHEREFORE, Opposer requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Opposer requests that the requisite filing fee of \$300.00 be charged to the deposit account of Neal, Gerber & Eisenberg, LLP, Account No. 502261.

Respectfully submitted,

Date: August 17, 2011

By: /James P. Muraff /  
James P. Muraff  
One of the Attorneys for  
Redbox Automated Retail, LLC  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street  
Chicago, Illinois 60602-3801  
(312) 269-8000 (telephone)  
(312) 269-1747 (fax)

**CERTIFICATE OF TRANSMISSION**

I, James P. Muraff, hereby certify that the foregoing *Notice of Opposition* is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: August 17, 2011

By: / James P. Muraff/  
Attorney for Redbox Automated Retail, LLC  
James P. Muraff  
Neal, Gerber & Eisenberg LLP  
Two North LaSalle Street, Suite 1700  
Chicago, Illinois 60602-3801  
(312) 269-8000

**CERTIFICATE OF SERVICE**

I, James P. Muraff, an attorney, state that, pursuant to 37 CFR §§ 2.101 and 2.119, I caused a true and correct copy of the foregoing Notice of Opposition to be served upon:

Stanley Lee Barnes  
DBA Red Box Tickets USA, LLC  
3127 St. Vincent  
St. Louis, MO 63104  
United States

via Overnight Courier postage prepaid on August 17, 2011.

/James P. Muraff /  
James P. Muraff



# Exhibit A

**Int. Cl.: 9**

**Prior U.S. Cls.: 21, 23, 26, 36, and 38**

**Reg. No. 2,919,854**

**United States Patent and Trademark Office**

**Registered Jan. 18, 2005**

**TRADEMARK  
PRINCIPAL REGISTER**

**REDBOX**

FUTURE PROPERTY MANAGEMENT, INC. (DE-  
LAWARE CORPORATION)  
1013 CENTRE ROAD  
WILMINGTON, DE 19805

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

SN 78-201,219, FILED 1-8-2003.

FOR: VENDING MACHINES, IN CLASS 9 (U.S.  
CLS. 21, 23, 26, 36 AND 38).

JENNIFER CHICOSKI, EXAMINING ATTORNEY

**Int. Cl.: 41**

**Prior U.S. Cls.: 100, 101 and 107**

**Reg. No. 2,988,869**

**United States Patent and Trademark Office**

**Registered Aug. 30, 2005**

**SERVICE MARK  
PRINCIPAL REGISTER**

**REDBOX**

FUTURE PROPERTY MANAGEMENT, INC. (DE-  
LAWARE CORPORATION)  
1013 CENTRE ROAD  
WILMINGTON, DE 19805

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

SER. NO. 78-201,199, FILED 1-8-2003.

FOR: AUTOMATED DVD RENTAL SERVICES, IN  
CLASS 41 (U.S. CLS. 100, 101 AND 107).

BARBARA GAYNOR, EXAMINING ATTORNEY

**Int. Cl.: 35**

**Prior U.S. Cls.: 100, 101 and 102**

**Reg. No. 3,082,012**

**United States Patent and Trademark Office**

**Registered Apr. 18, 2006**

**SERVICE MARK  
PRINCIPAL REGISTER**

**REDBOX**

REDBOX AUTOMATED RETAIL, LLC (DELA-  
WARE CORPORATION)  
ONE MCDONALD'S PLAZA  
OAK BROOK, IL 60523

FOR: VENDING SERVICES, NAMELY, PROVID-  
ING RETAIL FACILITIES FEATURING AUTOMA-  
TED DVD RENTAL, IN CLASS 35 (U.S. CLS. 100, 101  
AND 102).

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,919,854.

SER. NO. 78-514,282, FILED 11-10-2004.

CAROLINE WOOD, EXAMINING ATTORNEY

**Int. Cls.: 9 and 41**

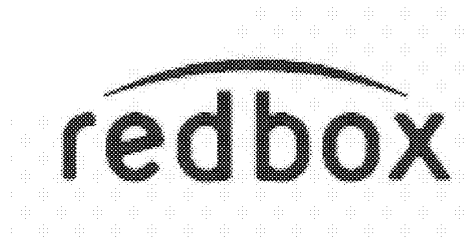
**Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 107**

**United States Patent and Trademark Office**

**Reg. No. 3,229,436**

**Registered Apr. 17, 2007**

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**



REDBOX AUTOMATED RETAIL, LLC (DELA-  
WARE LTD LIAB CO)  
ONE TOWER LANE, SUITE 1200  
OAKBROOK TERRACE, IL 60181

FOR: VENDING MACHINES, IN CLASS 9 (U.S.  
CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-0-2004; IN COMMERCE 5-0-2004.

FOR: RENTAL OF PRE-RECORDED DVDS ON A  
VARIETY OF SUBJECTS THROUGH AUTOMATED  
VENDING MACHINES, IN CLASS 41 (U.S. CLS. 100,  
101 AND 107).

FIRST USE 5-0-2004; IN COMMERCE 5-0-2004.

OWNER OF U.S. REG. NOS. 2,919,854, 2,988,869,  
AND 3,082,012.

THE MARK CONSISTS OF THE WORD "RED-  
BOX" WITH AN ARC OVER THE WORD.

SER. NO. 78-866,011, FILED 4-20-2006.

GINA HAYES, EXAMINING ATTORNEY